

REMARKS

Applicant thanks the Examiner for acknowledging the claim for priority under 35 U.S.C. § 119. Applicant also requests that the Examiner acknowledge receipt of a certified copy of the instant Application's priority document, PCT/IE/00082, which was submitted on January 14, 2002.

Applicant thanks the Examiner for considering the references cited with the *Information Disclosure Statements* filed January 14, 2002 and March 17, 2003.

Applicant thanks the Examiner for conducting a personal interview with Applicant's representatives (the undersigned) on July 11, 2005. At the interview, Applicant's representatives demonstrated that the subject matter of claims 49-77 was pending in the instant Application within one year of the issuance of the relevant claims of U.S. Patents 6,171,327 B1 and 6,544,250 (for the specific reasons discussed in detail below). In view of this demonstration, the Examiner agreed to withdraw the current rejections, and conduct a further search.

Status of the Application

Claims 49-77 are all the claims pending in the Application. Claims 49-77 stand rejected.

Interference Rejection

The Examiner has rejected claims 49-77 under 35 U.S.C. § 135(b), as allegedly not being incorporated in the instant Application prior to one year from the date on which U.S. Patent No. 6,171,327 was granted. Applicant respectfully disagrees and requests reconsideration of the rejection.

Claims 49-51

As discussed in the April 8, 2004 *Preliminary Amendment*, currently pending claims 49-51 (which were added by the April 8, 2004 *Preliminary Amendment*) correspond to claims 1-3 of U.S. Patent No. 6,171,327, which issued on January 9, 2001. These claims 49-51 were added on April 8, 2004, which is more than one year after the January 9, 2001 issue date of U.S. Patent No. 6,171,327 (hereinafter “the ‘327 Patent”).

However, as shown herein, claims 49-51 of the instant Application do not differ in any material limitation from various ones of the original claims 1-48 of international Application PCT/IE00/00097 (from which the instant application is a direct continuation) filed August 11, 2000.¹ As such, Applicants were claiming the same invention within one year of the issue date of the ‘327 Patent. *In Re Berger*, 279 F.3d 975, 982; 61 U.S.P.Q.2D (BNA) 1523 (Fed. Cir. 2002). Thus, the subject matter recited in pending claims 49-51 was on file before the January 9, 2001, issue date of U.S. Patent No. 6,171,327, and therefore claims 49-51 are proper under 35 U.S.C. § 135(b).

The following table shows the correspondence between: (1) claims 1-3 of the ‘327 Patent; (2) pending claims 49-51 of the instant Application; and (3) originally filed independent claim 1 (and dependent claims 2-5, 7, 11, 25 and 26) of International Application PCT/IE00/00097. Particularly relevant portions of the claims of International Application PCT/IE00/00097 are bolded.

¹ The original claims 1-48 of the instant Application are substantial duplicates of claims 1-48 of International Application PCT/IE00/00097.

U.S. Patent No.: 6,171,327	Pending Claims of the Instant Application	PCT/IE00/00097 Independent Claim 1	PCT/IE00/00097 Dependent Claims
1. A filter assembly, comprising:	49. A filter retrieval device, comprising:	1. A retrieval device for retrieving a medical device from a body lumen, through a lesion or a treatment device proximal of the medical device, the retrieval device comprising	26. A retrieval device as claimed in claim 23 wherein the medical device is an embolic filter device which is mounted or engagable with on a guidewire for retrieval into the retrieval space.
a catheter including an elongate shaft having a proximal end and a distal end	a catheter including an elongate tube having a proximal end and a distal end	a retrieval catheter having a proximal end and a distal end	
and a housing disposed at the distal end, the housing having a distal end;	and a housing disposed at the distal end, the housing having a distal end;	the retrieval catheter defining a retrieval space into which a medical device is retrieved	
an elongate wire extending at least in part through the catheter, the elongate wire having a proximal end and a distal end;	a guidewire extending at least in part through the catheter, the guidewire having a proximal end and a distal end;	[the claimed retrieval device operates on guidewires, as is evidenced by dependent claims 3 and 25]	3. A retrieval device as claimed in claim 2 wherein the centring catheter has an internal bore extending at least partially along its length for threading the retrieval device over a guidewire. 25. A retrieval device as claimed in any preceding claim wherein the medical device is mounted on or engaging with a guidewire and wherein the guidewire is pulled proximally for retrieval of the medical device into the retrieval space.
a filter connected to the elongate wire proximate the distal end of the elongate wire,	a filter connected to the guidewire proximate the distal end of the guidewire,	[the claimed medical devices is provided to retrieve filters, as is evidenced by dependent claim 26]	26. A retrieval device as claimed in claim 23 wherein the medical device is an embolic filter device which is mounted or engagable with on a guidewire for retrieval into the retrieval space.
the filter is moveable from a position outside the housing to a position at least in part inside the housing; and	the filter is moveable from a position outside the housing to a position at least in part inside the housing; and	[the claimed retrieval device is provided to retrieve filters into the device for removal, as is evidenced by dependent claim 26]	26. A retrieval device as claimed in claim 23 wherein the medical device is an embolic filter device which is mounted or engagable with on a guidewire for retrieval into the retrieval space.
a housing insert disposed within the housing	a centering catheter disposed within the housing	a centring means having an introduction configuration for introduction of the retrieval device through a lesion or a treatment device and a retrieval configuration in which the medical device is retrieved into the retrieval space of the retrieval catheter.	2. A retrieval device as claimed in claim 1 wherein the centring means is a centering catheter having a distal end, the centering catheter being mounted in the retrieval catheter for movement between the introduction configuration in which the distal end of the centering catheter projects distally from the distal end of the retrieval catheter and the retrieval configuration in which the distal end of the centering catheter is proximal of the retrieval space of the retrieval catheter.

and extending distally therefrom when the filter is in the position outside the housing.	and extending distally therefrom when the filter is in the position outside the housing.	[the claimed centering means is provided to ease the retrieval of the filter, and thus necessarily extends from the retrieval catheter, as is evidenced by dependent claim 2]	2. A retrieval device as claimed in claim 1 wherein the centring means is a centering catheter having a distal end, the centering catheter being mounted in the retrieval catheter for movement between the introduction configuration in which the distal end of the centering catheter projects distally from the distal end of the retrieval catheter and the retrieval configuration in which the distal end of the centering catheter is proximal of the retrieval space of the retrieval catheter.
2. The filter assembly in accordance with claim 1, wherein the insert tapers distally.	50. (Previously Presented) The filter retrieval device in accordance with claim 49, wherein the centering catheter tapers distally.		7. A retrieval device as claimed in any of the claims 2 to 6 wherein the distal end of the centering catheter is tapered distally inwardly to guide the open mouth through the body lumen.
3. The filter assembly in accordance with claim 1, wherein the insert is releasably connected to the distal end of the housing.	51. (Previously Presented) The filter retrieval device in accordance with claim 49, wherein the centering catheter is releasably engaged to the distal end of the housing.		11. A retrieval device as claimed in any of the claims 8 to 10 wherein the distal end of the centering catheter is sealably engagable to the distal end of the retrieval catheter. 4. A retrieval device as claimed in claim 2 or 3 wherein the centering catheter is slidably movable in the retrieval catheter from the introduction configuration to the retracted retrieval configuration. 5. A retrieval device as claimed in any of claims 2 to 4 wherein the centring catheter is removable from the retrieval catheter.

As an additional aide to understanding the correspondence between: (1) claims 1-3 of the '327 Patent; (2) pending claims 49-51 of the instant Application; and (3) originally filed claims 1-5, 7, 11, 25 and 26 of International Application PCT/IE00/00097, Applicant has prepared and encloses herewith a color-coded (features that do not differ in any material limitation are highlighted in the same color) correspondence chart as Appendix I.

Claims 52-77

As discussed in the April 8, 2004 *Preliminary Amendment*, currently pending claims 52-77 (which were added by the April 8, 2004 *Preliminary Amendment*) correspond to claims 1-6, 9-23 and 26-30 of U.S. Patent No. 6,544,280, which issued on April 8, 2003.

As U.S. Patent No. 6,544,280 issued on April 8, 2003, claims 52-77 were copied to the instant Application within one year of the issuance of U.S. Patent No. 6,544,280, and are therefore proper under 35 U.S.C. § 135(b).²

Claim Objection

The Examiner has objected to claims 49-77 due to alleged informalities. Applicant respectfully disagrees with the Examiner's position that "a centering catheter disposed within" is in any way incorrect, as this language is clear on its face. Further, Applicant notes that the Examiner has not explained why she believes this language to be incorrect, therefore preventing Applicant from conducting a more detailed analysis, or providing more detailed comments. Thus, withdrawal of this objection is respectfully requested.

Anticipation Rejection

The Examiner has rejected claims 49-77 under 35 U.S.C. § 102(e) as allegedly being anticipated by *Daniel et al.* (US 6,171,327; hereinafter "*Daniel*"). This rejection is respectfully traversed.

In view of the above showing that all of the claims 49-77 were properly copied into the above Application, Applicant respectfully requests that the Examiner withdraw the pending

² As an additional matter, each of the claims 1-6, 9-23 and 26-30 of U.S. Patent No. 6,544,280 contain claim features that were not recited in any of the claims of its parent Application, U.S. Patent No. 6,171,327, and thus cannot be said to have been on file in that earlier Application

Response Under 37 C.F.R. § 1.111
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rejection under 35 U.S.C. § 135(b) to permit an interference with U.S. Patents 6,171,327 and 6,544,280.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 49-77 are allowable over the prior art, and are in condition such that an interference should be declared between: (1) the instant Application; and (2) U.S. Patents 6,171,327 B1 and 6,544,250.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,


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